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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,557	12/21/1999	GREGORY ROSE	PA990485	3776

23696 7590 07/14/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
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EXAMINER	
MEISLAHN, DOUGLAS J	

ART UNIT	PAPER NUMBER
2137	9

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/468,557	ROSE ET AL.	
	Examiner	Art Unit	
	Douglas J. Meislahn	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-10,12-16 and 18-20* is/are rejected.

7)☒ Claim(s) *5,11 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 15 April 2004 that amended claims 5, 11, and 17. While the examiner agrees that the deficiency in the declaration is minor, its correction is still required. The objection to claims 1, 7, and 13 has been dropped, as has the 112 rejection of claims 5, 11, and 17.

Response to Arguments

2. Applicant's arguments filed 15 April 2004 have been fully considered but they are not persuasive.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, proving, as opposed to claiming, an identity (taught by Fieres et al.) is an improvement that would motivate a person of ordinary skill in the art to combine the puzzle of Fieres et al. with Davis et al.'s identification system.

4. Applicant argues that the puzzle of the claims is not shown as being constructed in response to information received from an user. The rejection has clearly explained that the cookie, which is generated in response to receiving

information from an user, contains the puzzle. Applicant opines that the rejecting references fail to teach constructing a plurality of puzzles. Cookie systems are intended to handle multiple users, and thus Davis et al. anticipates applicant's plurality. A processor is required to solve a puzzle; consumption of the processor's power is the consumption of a resource. The solution to Fieres et al.'s puzzles proves an identity and thus contains information about an user.

Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because the "original and first" clause states that the inventor is the "sole" inventor, despite there being two named invention in the instant application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3, 7-9, 13-15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (5796952) in view of Fieres et al. (5841870).

In lines 5-24 of column 2, Davis et al. show a standard cookie procedure, with an user submitting information to a recipient, that information being incorporated into a cookie that is placed in the user's computer, and the user

sending the cookie, which acts as an identifier, to the recipient. As this applies to the first claim, the recipient's creation of the cookie reads on constructing a response that includes information submitted by an user. The placement of the cookie in the user's computer renders obvious sending the response to the user. And, returning the cookie to the recipient reads on returning a response. Davis et al. do not say that the cookie is a puzzle. In lines 45-52 of column 8, Fieres et al. teach using puzzles to prove identities. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for Davis et al.'s cookie to be a puzzle, as taught by Fieres et al., so that the user's identity would be proven.

Davis et al.'s cookies include user preferences, which render obvious demographic information and thus claim 2. Selecting preferences obviously can include an identity of the user, thereby rendering claim 3 obvious.

Claims 7-9 and 13-15 are rejected for largely the same reasons as claims 1-3 because they contain the same limitations embodied in different statutory classes. Claim 19 is rendered obvious because cookies are meant to be used by multiple users. The limitations of claim 20 are met by Fieres et al.'s puzzles.

8. Claims 4, 6, 10, 12, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. and Fieres et al. as applied to claims 1, 7, and 13 above, and further in view of Menezes et al. (*Handbook of Applied Cryptography*).

Davis et al. and Fieres et al. render obvious a cookie system in which the cookie doubles as a puzzle that can prove a cookie-holder's identity. They do

not say that the cookie is created by altering information received from an user and then exponentiating the result. On pages 403-404, Menezes et al. teach challenge-response authentication based on public-key decryption. In this method, a challenge is concatenated with a name and encrypted with an user's public key. The result is sent to the user, who decrypts the encrypted challenge and sends it back, thereby verifying its identity. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the identity verification technique described in Menezes et al.'s book as the puzzle in Davis et al. and Fieres et al.'s combined system. The witness reads on portion of the derived value that is combined with the exponentiated value. The scope of Menezes et al.'s public key algorithm encompasses the limitations of claim 6. Claims 10, 12, 16, and 18 are rendered obvious for largely the same reasons.

Allowable Subject Matter

9. Claims 5, 11, and 17 are objected to as being dependent upon a rejected base claim, but they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas J. Meislahn
Examiner
Art Unit 2137

DJM